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| FITZPATRICK CELLA HARPER & SCINTO | | | EXAMINER | |
| 1290 Avenue of the Americas | | | HUNTSINGER, PETER K | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/609,369 | MIMA, TSUYOSHI | |
| Examiner | Art Unit | | |
| Peter K. Huntsinger | 2625 | | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 April 2010.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7 and 9-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-7 and 9-11 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 9 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 9 and 12 are directed to data structures embodied on a computer readable medium. The broadest reasonable interpretation of a claim drawn to a computer readable medium includes forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media. See *Subject Matter Eligibility of Computer Readable Medium*, Jan. 26, 2010. The Applicant's specification does not limit computer-readable medium to non-transitory embodiments, and therefore claims 9 and 12 are non-statutory. The Examiner suggests amending the claims to include "non-transitory computer readable medium" or similar language.

Claim Rejections - 35 USC § 103

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parry Patent 6,972,863, and further in view of Henry Patent 7,062,534.

Referring to **claims 1, 7 and 9**, Parry '863 discloses an image processing apparatus (Printer 10 of Fig. 1, col. 3, lines 8-11), comprising:

read means for reading an image on a document that contains image storage information representing a location where an original image of the documents is stored (Block 130 of Fig. 2, col. 3-4, lines 65-67, 1-9, detects barcode containing URL);

authentication means for authenticating a user by using authentication information (col. 4, lines 9-12, PIN number used to verify authorization to access the remote URL);

search means for searching the original image of the document from an image storage device which stores the original image of the document, on the basis of the image storage information when the user is authenticated by said authentication means (col. 4, lines 29-36, printer retrieves request document);

setting means for setting a destination for the original image of the document in accordance with the authentication information (Block 170 and 180 of Fig. 2, col. 4, lines 35-46, printer at which the user is present retrieves the request document and the user

can make a selection of the transmission of the document to another printer or other appropriate device); and

output means for outputting the original image of the document searched by said search means to the destination set by said setting means (Block 170 and 180 of Fig. 2, col. 4, lines 35-46, printer retrieves request document and transmits the document to another printer).

Parry '863 does not disclose expressly setting a destination for the original image independent of a manual designation.

Henry '534 discloses setting means for setting a destination for the original image of the document, wherein, in a first case where transmission of the original image of the document is set, the setting means automatically setting sets the destination for the original image of the document in accordance with the authentication information, a destination for the original image of the document to an address of the user authenticated by said authentication means, the set destination being different from said image processing apparatus, wherein in the first case the destination is automatically set independently of a manual designation upon the authentication of the user and independently of the image on the document (col. 4, lines 25-56, once logged in, the user is permitted to either call up a saved address, number, or distribution list from his or her address book as indicated at block 402 of Fig. 4), and wherein in a second case where transmission of the original image of the document is not set, the setting means manually sets the destination for the original image of the document (col. 4, lines 25-56, if the user does not choose to select such an address, number, or list in this manner, he

or she can begin to enter the destination e-mail address, fax number, or list name to which the document will be transmitted as indicated at block 404 in Fig. 4).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to automatically set a destination for an image without manual designation. The motivation for doing so would have been to allow a user to select a transmission destination without the tedious task of regularly inputting a destination. Therefore, it would have been obvious to combine Henry '534 with Parry '863 to obtain the invention as specified in claims 1, 7 and 9.

Referring to **claim 2**, Parry '863 discloses wherein the image storage information includes information represented by a barcode (Block 130 of Fig. 2, col. 3-4, lines 65-67, 1-9, detects barcode containing URL).

Referring to **claim 3**, Parry '863 discloses where the image storage device includes a server device connected via a network (col. 3, lines 33-37, accesses remote device 70 by means of network).

Referring to **claim 5**, Parry '863 discloses means for causing a printing device to print the image storage information, and causing the image storage device to store the original image of the document (Block 220 of Fig. 2, col. 4, lines 53-55, document is printed).

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parry Patent 6,972,863 and Henry Patent 7,062,534 as applied to claim 1 above, and further in view of applicant's admitted prior art.

Referring to **claim 4**, Parry '863 discloses outputting the original image to the destination set by said setting means but does not disclose expressly attaching the original image to an e-mail and outputting the e-mail.

The applicant's admitted art teaches wherein output means attaches the original image to E-mail, and outputs the E-mail with the original image (page 1, lines 23-27). At the time of the invention, it would have obvious to a person of ordinary skill in the art to email a scanned image to a server. The motivation for doing so would have been to send the image to a central location for long-term storage. Therefore, it would have been obvious to combine the applicant's admitted prior art with Parry '863 to obtain the invention as specified in claim 4.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parry Patent 6,972,863 and Henry Patent 7,062,534 as applied to claim 1 above, and further in view of Mori Patent 6,137,590.

Referring to **claim 6**, Parry '863 discloses where said output means outputs the original image but does not disclose expressly outputting the image without the image storage information.

Mori '590 discloses outputting an original image without the image storage information (col. 4, lines 15-20, identification code is not printed on the document or print image itself).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to print an original image without the URL barcode. The motivation for doing so

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would have been to produce a document free of distracting/unwanted marks.

Therefore, it would have been obvious to combine Mori '590 with Parry '863 to obtain the invention as specified in claim 6.

8. Claim 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parry Patent 6,972,863 and Henry Patent 7,062,534 as applied to claims 1, 7 and 9 above, and further in view of Mukai Patent 6,446,329.

Referring to **claims 10, 11 and 12**, Parry '863 discloses operating means for accepting an address designated as the destination from a user (Block 170 of Fig. 2, col. 4, lines 35-46, printer at which the user is present retrieves the request document and the user can make a selection of the transmission of the document to another printer or other appropriate device via user interface 40), but does not disclose expressly a first and second setting means.

Mukai '329 discloses operating means for accepting an address designated as the destination a user (col. 16, lines 4-19, an address which the facsimile is to be transmitted is specified on operator control panel 500)

second setting means for setting, as the destination, an address manually designated by said operating means in a case where the user is not authenticated (col. 16, lines 20-46, the facsimile is sent enclosed in a PDL format if the page ID is not recorded in the page ID reference table in S414 of Fig. 11),

wherein the output means output the original image of the document searched by said search means to the destination of the address set by said setting means (col. 16-

17, lines 59-67, 1-4, PDL data equivalent to the master page will be sent to the destination if the page ID existing in the print image is found in the page ID reference table in S418 of Fig. 11), or output the image read by said read means to the destination of the address set by said second setting means (col. 16, lines 20-46, the facsimile is sent enclosed in a PDL format if the page ID is not recorded in the page ID reference table in S414 of Fig. 11).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to output an original image of a document if a user is authenticated and output a copy of the document if the user is not authenticated. The motivation for doing so would have been to enable document copying when a high quality original is not readily available to print. Therefore, it would have been obvious to combine Mukai '329 with Parry '863 to obtain the invention as specified in claims 10-12.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

/Peter K. Huntsinger/
Examiner, Art Unit 2625

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